

Remarks

Claims 1, 3, 5 and 7-10 are pending. Applicant has canceled claim 8 as depending from a previously canceled claim.

No new matter has been added.

Rejections Under 35 U.S.C. §103

The Examiner maintained the rejection of claims 1, 3, 5 and 7-10 under 35 U.S.C. §103(a) as being unpatentable over JP 57-206614 (hereinafter JP '614) in view of U.S. Patent No. JP 61-260014 (hereinafter JP '014). Applicant respectfully requests reconsideration of the rejection.

The Examiner's rejection is based on the teaching of a hydrous patch containing a polyhydric alcohol in the JP '014 reference. Office Action at page 3. The Examiner admits that the JP '614 reference, which teaches a sheet-form adhesive preparation, does not teach a glycol or a polyhydric alcohol. Office Action at page 2. The Examiner finds that the combination of these two references renders the claimed invention unpatentable as obvious.

A comparison of the features of the claimed invention and of the products described by the '614 reference and the '014 reference is provided below:

Component	Claimed invention	JP '614 reference	JP '014 reference
glycol	yes, 1-30 wt%	No	No
polyhydric alcohol	optional (claims 9, 10)	No	Yes
glycerin	optional (claims 9, 10)	No	Yes, 39.5-49 wt%

Applicant wishes to call to the Examiner's attention that claim 1 requires the presence of a specific proportion of a glycol (1-30 wt%). Applicant previously added the limitation on the amount of glycol solely to make the difference between the prior art and the claimed invention even clearer, even though Applicant does not believe that patentability of the claims rests on having a particular weight percentage of glycol. Instead, the patentability of the claims over the cited prior art is based on the fact that the JP '614 patent and the JP '014 patent are totally silent

about the adhesive preparation containing a glycol. Glycerin (in a specific amount) is disclosed in the JP '014 patent, but this is a polyhydric alcohol, not a glycol.

Claim 1 does not recite a polyhydric alcohol. The presence of polyhydric alcohols is optional, as it is found only in dependent claims 9 and 10, and only in combination with the specific proportion of a glycol of claim 1. Accordingly, the combination of references does not teach or suggest the specific limitations recited in the claims.

Even though Applicant previously amended the claims to recite a particular proportion of glycol (1-30%), the Examiner apparently has not taken this amended scope of the claims into consideration when making the present rejection. The Examiner merely indicated that "the cancellation of 'a polyhydric alcohol' does not rebut the argument of the mixing of two components." Office Action at page 4. The Examiner's comments in this regard may be directed to claims 9 and 10, which include both glycol and polyhydric alcohol in the compositions. Nevertheless, claims 9 and 10 contain a recitation of glycol that is neither taught nor suggested by the cited prior art (alone or in combination).

The cited references also do not provide any motivation to modify the amount of glycol present in the preparation, nor has the Examiner provided evidence of any such motivation, as is required for making a *prima facie* case of obviousness. Moreover, the Examiner has not provided any evidence that one of ordinary skill in the art would reasonably expect success in modifying the teachings of these references to obtain the claimed invention.

Therefore, the present rejection fails to provide any of the three aspects required for making a proper *prima facie* case of obviousness (a teaching of all elements of the claimed invention, motivation to combine the teachings of the references, and a reasonable expectation of success in doing so). Accordingly, Applicant asserts that the invention as now claimed is not obvious in view of the combination of the JP '614 patent and the JP '014 patent, which do not teach the presence of glycol alone or in combination with a polyhydric alcohol, and respectfully requests that the Examiner withdraw the rejection of the claims as unpatentable under 35 U.S.C. 103.

Applicant also previously provided a second basis for overcoming the obviousness rejection, and the Examiner has not rebutted this second basis. Applicant previously noted that neither the JP '614 reference nor the JP '014 reference describe the control of the heat quantity

required for "water evaporation heat" by adding the specific amount of a glycol, which Applicant's invention demonstrates a greatly improved refreshing feeling and user satisfaction.

This feature is recited in the claims. Claim 1 as pending only recites a specific quantity of heat required (0.6 to 13 (cal) per cm²). The combination of JP '614 and JP '014 fails to teach or suggest a sheet-form adhesive patch with this element, and therefore for this additional reason the combination of JP '614 and JP '014 does not render the claimed invention obvious.

Accordingly, in view of the claim amendments and remarks above, Applicant respectfully requests reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 103 as obvious over JP '614 in view of JP '014.

CONCLUSION

In view of the foregoing remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this response, that the application is not in condition for allowance, the Examiner is respectfully requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
Kazunori Muta et al., Applicant

By: 

John R. Van Amsterdam, Ph.D.
Reg. No. 40,212
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210-2211
Telephone: (617) 646-8000

Docket No. H0666.70002US00
Date: February 18, 2005
X03/22/05